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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/763,067	01/22/2004	Brian C. Gabbard	SHAK-1-1002	3702
25315	7590	12/29/2005	EXAMINER	
BLACK LOWE & GRAHAM, PLLC			DEVOTI, PAUL D	
701 FIFTH AVENUE			ART UNIT	
SUITE 4800			PAPER NUMBER	
SEATTLE, WA 98104			3637	

DATE MAILED: 12/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/763,067	<b>Applicant(s)</b> GABBARD ET AL.	
	<b>Examiner</b> Paul Devoti	<b>Art Unit</b> 3637	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) 17-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16, 27 and 28 is/are rejected.
- 7) ☒ Claim(s) 8 and 16 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election with traverse of Species 1 (Figures 1-7) in the reply filed on December 5, 2005 is acknowledged. The traversal is on the ground(s) that the designated species are neither independent nor distinct in that the species are all related as embodiments of a shingle panel. This is not found persuasive because each specie is distinct from each other, as seen in the differences in structure and designs. These species are independent from each other and there is no relationship between them. Each specie is used independently, unconnected in operation from the other species.

As for applicant's comment regarding undue burden, the examiner disagrees. To examine all of the disclosed species, the examiner would have to search for every little structural detail of each and every specie. As such, this would be a serious burden on the examiner. Since there are no generic claims and all of the elected claims are rejected, applicant's comment regarding allowable generic linking claims is moot.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 17- 26 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on December 5, 2005.

***Specification***

3. Claims 8 and 16 are objected to because of the following informalities: Remove the word "the" in the phrase "wherein the at least". Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

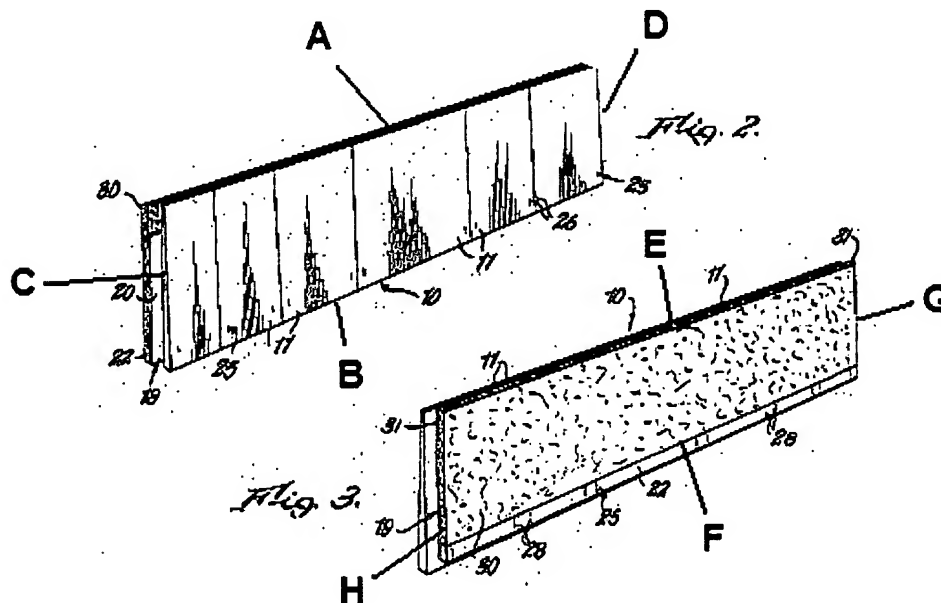
A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 2, 3, 4, 5, 9, 10, 11, 12, and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Fink et al. (US 3095671). Fink et al. discloses a shingle panel with a plurality of shingles (11), and each shingle (11) having a first edge (A), second edge (B), third edge (C), and a fourth edge (D), where the first edge (A) is opposite the second edge (B) and the third edge (C) is opposite the fourth edge (D). Additionally, at least one backing (30) is affixed to the shingles, where the backing has first edge (E), second edge (F), third edge (G), and fourth edge (H), where the first edge (E) is opposite the second edge (F) and the third edge (G) is opposite the fourth edge (H). Additionally, the first edge (E) of the backing (30) is substantially aligned with the first edge (A) of the shingles, the second edge (F) of the backing is offset from the second edge (B) of the shingles, the third edge (G) of the backing is offset from the third edge

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(C) of the shingles, and the fourth edge (H) of the backing is offset from the fourth edge (D) of the shingles. Regarding claims 2 and 10, Fink et al. discloses that the distance between the first and second edges (E, F) of the backing is less than the distance between the first and second edges (A, B) of the shingles. Regarding claims 3 and 11, the distance between the third and fourth edges (G, H) of the backing, when measured, is substantially the same as the distance between the third and fourth edges (C, D) of the plurality of shingles. Regarding claims 4 and 12, Fink et al. discloses the backing (30) is affixed to the shingles by glue (Column 3, line 59-63). Regarding claims 5 and 13, at least one of the plurality of shingles (11) has a thickness and the thickness is tapered from the second edge (B) to the first edge (A) of the shingle.



Fink et al. (US 3095671) Figures 2 and 3

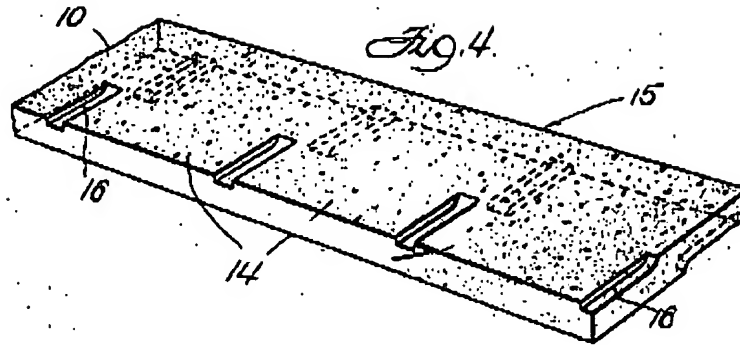
***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 6 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fink et al. in view of Mendez (US 4651492). Fink et al. discloses everything previously mentioned, but does not teach at least one groove extending between the first edge and second edge of the shingle. Mendez, however, discloses a shingle with a groove (50) extending between a first edge (28) and second edge (22). Therefore, it would have been obvious to one having ordinary skill in the art at the time of invention to modify Fink et al.'s shingle panel to include a shingle with a groove extending substantially between the first edge and second edge of the shingle, as taught by Mendez, to allow water to quickly run off the shingle.

5. Claims 7, 8, 15, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fink et al. in view of Cumfer (US 1534165). Fink et al. discloses everything previously mentioned, but does not disclose that the backing comprises at least one breathing groove substantially parallel with the third and fourth edges of the backing, and at least one groove extends from the first edge of the backing. Cumfer, however, discloses a backing of a shingle (10) with a groove (16) that extends from the first edge and is substantially parallel with the third and fourth edges. Therefore, it would have been obvious to one having ordinary skill in the art at the time of invention to modify Fink et al.'s shingle panel to include a groove extending from the first edge of the backing and substantially parallel with the third and fourth edges, as taught by Cumfer to make the shingle more durable and the resulting roof more weather resistant.



Cumfer (US 1534165) Figure 4

6. Claims 27 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fink et al. The method claims are an obvious method of using the shingle panel of Fink et al.

### **Conclusion**

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Utley (US 108068) discloses a tile offset from its backing on four sides. Donaldson (US 322917) discloses a roofing tile with a backing and a groove that collects and carries water. Lyman (US 2148167) discloses a roofing or siding material that can be attached using glue. Borgolte (US 618197) discloses a tile with grooves. Fischer (US 1447290) discloses a shingle with an offset backing. Stewart (US



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4680909) discloses a roofing system with a panel that has an offset backing. Marvick et al. (US 479441) discloses a roofing tile with two offset edges. Donaldson (US 368387) discloses siding with a tapered thickness.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Devoti whose telephone number is 571-272-2733. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lanna Mai can be reached on 571-272-6867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PD *PD*  
12/22/05

LANNA MAI  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600

*Lannama*